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Erin Cowles

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/690,170 Confirmation No. 3947
Applicant : Khandros
Filed : October 21, 2003
TC/A.U. : 2829
Examiner : Tung X. Nguyen

Docket No. : P197-US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF FINAL
RESTRICTION REQUIREMENT**

To Whom It May Concern:

In response to the final restriction requirement dated February 24, 2006, Applicant respectfully requests withdrawal of that requirement in light of the following remarks.

REMARKS

1. The Prosecution History

The Examiner has issued three Office Actions. In the first Office Action mailed on May 2, 2005, the Examiner rejected pending claims 1-44 on the merits. In response, Applicant argued that the prior art rejection was improper and amended the claims, including adding claims 45-55 that depend directly or indirectly on claims 1-44. The amendments also added new claims 56-61 which, like original claims 1-19, were directed to a method for testing.

In the next Office Action of October 19, 2005, the Examiner withdrew the pending prior art rejection and issued the restriction requirement between claims 1-19 and 56-61 (group I), claims 20-32 (Group II), and claims 33-55 (Group III), as well as an election of species requirement between Species A (claims 1-19) and Species B (claims 56-61) of group I. Applicant timely elected, with traverse, species B of Group I (claims 56-61) and also amended claims 1-19 to depend from claim 56, thereby making claim 56 generic to Species A and Species B.

Applicant traversed the restriction and election of species requirements on the grounds that the distinctiveness and/or the burden element were not met as required by M.P.E.P. § 803. In particular, Applicant argued that the Examiner has not met the burden requirement with regard to Groups I, II, and III because claims 1-44, which included the claims from Groups I and III and all of the claims of Group II, had already been examined in the Office Action dated May 2, 2005 and addressed in the Amendment dated August 2, 2005. As to Groups I and II, Applicant argued that the Examiner had not met the burden requirement because the Examiner acknowledged that those groups have the same classification (class 324, subclass 765), the Examiner did not allege the need for a separate search, and the Examiner did not provide support for the otherwise conclusory statement that Groups II and III acquired a separate status in the art because of their recognized divergent subject matter. As to the election of species requirement, Applicant argued that the Examiner failed to establish both the distinctness element and the burden element by not identifying the differences between Species A and Species B, by not providing any analysis or discussion supporting a conclusion that Species A and Species B are distinct, and by not even alleging that Species A and Species B had a separate classification or separate status in the art or would require a different field of search.

In spite of all of these arguments, the Examiner made the restriction requirement final in the next (and third) Office Action of February 24, 2006. The Examiner's reasoning was that the "inventions are classified in different classes and there are divergent subject matters and the search for the group I is not required [*sic*] the same search in groups II and III."

2. *The Office Guidelines*

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth those instances where the Office can impose a restriction requirement, including an election of species requirement. As set forth in the first paragraph of M.P.E.P. § 803, the Office can impose a restriction or an election of species requirement 35 U.S.C. § 121 where the inventions are independent or distinct. The next paragraph, however, creates an exception.

If the search and examination of all the claims in an application can be made without serious burden, the examiner **must** examine them on the merits, **even though they include claims to independent or distinct inventions.**

M.P.E.P. § 803 ¶ 2 (emphasis added). Thus, even where the Examiner can show the existence of independent or distinct inventions, all of the claims must be examined where no serious burden exists.

3. *Withdrawal Is Mandated*

The present application falls within directly within this exception of M.P.E.P. § 803 ¶ 2. Applicant elected specie B (claims 56-61) of group I (claims 1-19 and 56-61) for prosecution on the merits. The claims that were not elected include claims 20-32 (group II), 33-55 (group III), and claims 1-19 (specie A). But the Examiner has already searched and examined claims 1-44 when it issued the Office Action dated May 2, 2005. Therefore, there cannot be a serious burden on the Examiner in continuing to examine those claims.

Moreover, claims 45-55 depend, either directly or indirectly, on at least one of claims 1-44 and therefore include limitations of at least one of claims 1-44, which as mentioned above, were examined. Therefore, there cannot be a serious burden on the Examiner in examining claims 45-55.

Since there exists no serious burden, the Examiner "must" examine all of the claims in the application and cannot require a restriction or an election of species even though the

Examiner has argued that the claims are independent or distinct for the reasons set forth in paragraph 1 of the Office Action of February 24, 2006.

For the reasons of record, however, Applicant alternatively maintains that the Examiner has not substantiated that the inventions are not independent or distinct. For such reasons, as well, the restriction requirement should be withdrawn.

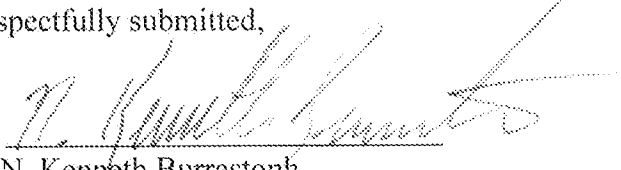
4. *Conclusion*

For these reasons, as well as those of record, Applicants respectfully request withdrawal of the restriction requirement and examination of all pending claims.

If the Office believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

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